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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/199,566 11/25/98 SAITO

H 981391

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EXAMINER

ROSEN, N

ART UNIT

PAPER NUMBER

2764

DATE MAILED:

*4*  
12/14/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/199,566**

Applicant(s)  
**Salto et al.**

Examiner  
**Nicholas D. Rosen**

Group Art Unit  
**2764**



☒ Responsive to communication(s) filed on Nov 25, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-37 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☒ Claim(s) 1, 3-20, 22-26, 28-30, 32-35, and 37 is/are allowed.

☒ Claim(s) 2, 21, 27, 31, and 36 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Claims 1-37 have been examined.

### *Specification*

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

3. Claim 1 is objected to because of the following informalities: In line 19 of page 76, "orchestrates" should be orchestrating. Also, since data is stored for a plurality of residents (line 3), "resident's" should be changed to "residents" in lines 2. Appropriate correction is required.
4. Claim 2 is objected to because of the following informalities: In line 21 of page 77, "orchestrates" should be "orchestrating." Also, since data is stored for a plurality of residents (line 4), "resident's" should be changed to "residents" in lines 3 and 8. Appropriate correction is required.
5. Claims 3-13 are objected to because of the following informalities: In claim 3, line 2 of page 79, "when" should be corrected to "and when," or possibly "and if." Appropriate correction is required.

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6. Claim 5 is objected to because of the following informalities: In line 18 of page 79, “passport recognizes” should be corrected to “passport and recognizes.” A comma after “passport” is optional. Appropriate correction is required.
7. Claim 6 is objected to because of the following informalities: In line 4 of page 80, “as to whether” should be corrected to “whether.” Appropriate correction is required.
8. Claims 14-25 are objected to because of the following informalities: In claim 14, lines 5 and 6 of page 82, “passport transaction” should be either “passport transactions” or “a passport transaction,” and similarly with the two occurrences of “passport transaction” in lines 15 and 16 of page 82. In line 4 of page 83, “based to the data” should be “based on the data.” In lines 6-7 of page 83, “prints . . . printed” is redundant, and should be probably be “has . . . printed.” Appropriate correction is required.
9. Claim 16 is objected to because of the following informalities: In line 21, page 83, “passport recognizes” should be corrected to “passport and recognizes.” A comma after “passport” is optional. Appropriate correction is required.
10. Claim 17 is objected to because of the following informalities: In line 7, page 84, “as to whether” should be corrected to “whether.” Appropriate correction is required.
11. Claim 26 is objected to because of the following informalities: In line 15 of page 86, “passport transaction” should be either “passport transactions” or “a passport transaction.” In line 15 of page 86, “by ways of” should probably be “via;” the whole conglomeration of prepositional phrases on lines 14 and 15 is difficult to parse, and might benefit from rewriting. In

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line 19 of page 86, "applied passport" should be "applied-for passport," "passport applied for," or "passport that has been applied for," and likewise in line 22. In line 20 of page 86, "inputting" should be "inputted," and likewise in line 25. Appropriate correction is required

12. Claim 27 objected to because of the following informalities: In line 11 of page 87, "applied passport" should be "applied-for passport," "passport applied for," or "passport that has been applied for," and likewise in line 15. Appropriate correction is required.

13. Claims 28-32 are objected to because of the following informalities: In claim 28, lines 2 and 3 of page 88, "passport transaction" should be either "passport transactions" or "a passport transaction." Furthermore, on page 88, line 25 and page 89, line 1, "applied passport" should be "applied-for passport," "passport applied for," or "passport that has been applied for." On line 2 of page 89, "o" should presumably be "of." In line 3 on page 89, a verb appears to be missing; "passport onto passport paper" appears to be an error for "passport printed onto passport paper." On line 8 of page 89, "replay" appears to be an error for "reply." On line 9 of page 89, "applied passport" should be "applied-for passport," "passport applied for," or "passport that has been applied for." Appropriate correction is required.

14. Claims 33-37 are objected to because of the following informalities: In claim 33, line 24 of page 90, "apparatuses" should be "apparatus." On page 91, line 1, "transaction" should be "transactions," and "by" should be "for." On page 91, lines 9 and 11, "transaction" should be "transactions." On page 91, line 25, "an applied passport" should be "an applied-for passport," "a passport applied for," or "a passport that has been applied for," and likewise in lines 1 and 18 of

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page 92. On page 92, the clauses beginning on lines 7 and 14 should each begin with the word "wherein." On page 92, lines 11 and 17, "replay" should be "reply." The word "true" is normally applied to propositions, not to persons, at least not in the context of applicant's usage; therefore, the examiner suggests that on line 12 of page 92, "true" be changed to "the person he claims to be," or to another phrase which will best convey applicant's intended meaning. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claim 2 recites the limitation "the passport" in line 10 of page 77. There is insufficient antecedent basis for this limitation in the claim.

18. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The expression "cash and change" in line 9 of page 85 is unclear in that several interpretations are possible. If "bills and coins" is the intended meaning, that phrase would be preferable, since "cash" can refer to both paper money and coins, while "change" can mean both

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“coins, normally of small value,” and “money, either bills or coins, returned to a purchaser because he paid for a purchase with money whose value exceeded the price.”

a. Alternatively, if applicant’s intended meaning is that the control unit controls both cash input and change returned to the user, that should be made explicit.

19. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 27 is an apparatus claim, but describes a series of steps, i.e., a method. Not even “data for identifying applications” can comprise a series of steps, although an apparatus may carry out computer readable instructions for performing a series of steps. Alternatively, a method may be claimed.

20. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The expression “cash and changes” in line 5 of page 90 is unclear in that several interpretations are possible. If “changes” is intended as a verb, it requires an object. However, the examiner thinks it more that “changes” is an error for “change.”

a. If “bills and coins” is the intended meaning, that phrase would be preferable, since “cash” can refer to both paper money and coins, while “change” can mean both “coins, normally of small value,” and “money, either bills or coins, returned to a purchaser because he paid for a purchase with money whose value exceeded the price.”

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b. Alternatively, if applicant's intended meaning is that the control unit controls both cash input and change returned to the user, that should be made explicit.

21. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The expression "cash and changes" in line 13 of page 93 is unclear in that several interpretations are possible. If "changes" is intended as a verb, it requires an object. However, the examiner thinks it more that "changes" is an error for "change."

a. If "bills and coins" is the intended meaning, that phrase would be preferable, since "cash" can refer to both paper money and coins, while "change" can mean both "coins, normally of small value," and "money, either bills or coins, returned to a purchaser because he paid for a purchase with money whose value exceeded the price."

b. Alternatively, if applicant's intended meaning is that the control unit controls both cash input and change returned to the user, that should be made explicit.

***Allowable Subject Matter***

22. Claim 1 would be allowable if rewritten or amended to overcome the objection(s) set forth in this Office action.

23. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken as a whole, fails to teach or suggest a passport transaction apparatus connected to a residents' database storing therein identification data of the residents and also



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connected to a center which executes an examination for issuance of passports through a communication line, said apparatus comprising: a communication unit for communicating with said center; an image input unit for inputting an image of the applicant for a passport; a display unit for displaying a guidance for the procedure for the passport transaction; a data input unit for inputting data for the application according to the procedure for passport transaction displayed on said display unit; a sign input unit for inputting a sign of the applicant; and a control section for transmitting the data inputted by each of the said input units to said center by using said communication unit and orchestrating said center so as to determine whether the applied passport is to be issued or not based on the identification data for the applicant which has been recorded in said resident database and on each of the transmitted input data.

24. Claim 2 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, and objections set forth in this Office action.

25. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken as a whole, fails to teach or suggest a passport transaction apparatus connected through a communication line to a center which executes an examination for issuance of passports as well as to a residents' database which stores identification data of residents for providing services for issuing passports to applicants, said apparatus comprising: a communication unit for communicating with said center and with said residents' database; an image input unit for inputting an image of an applicant for a passport; a data input unit for inputting data for the application according to the procedure for passport transaction displayed on

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said display unit; a sign input unit for inputting a sign of the applicant; and a control unit for transmitting the data inputted by each of said input units and the identification data of the applicant fetched using said communication unit to said center by using said communication unit and orchestrating said center so as to determine whether the passport is to be issued or not based on the transmitted data.

26. Claims 3-13 would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

27. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken as a whole, fails to teach or suggest a passport transaction apparatus connected to a center which provides the data for issuance of a certificate for an applicant and executes examination for issuance of passports for processing passport transactions through communication with the center via a communication line, said apparatus comprising: a communication unit for communicating with said center; an image input unit for inputting an image of the applicant; a display unit for displaying a guidance for the procedure for passport transaction; a data input unit for inputting data for passport transaction according to the procedure on said display unit; a printer unit for printing the image inputted by the image input unit and contents of the passport on a passport paper prepared previously; an issuer unit for issuing a passport obtained by printing with said printer unit; and a control unit for controlling the communications by said communications unit, image input by said image input unit, display by said display unit, data input by said data input unit and issuance of a passport by said issuer unit;

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wherein said control unit sends the data inputted by each of said input units to said center using said communication unit and orchestrates said center so as to determine whether the passport is to be issued or not, and when it is determined that the passport is to be issued, makes the printer unit print the image of the applicant inputted by said image input unit and contents of the passport onto a passport paper prepared previously, and makes the issuer unit issue the passport obtained by printing.

28. Claims 14-25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, and objections set forth in this Office action.

29. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken as a whole, fails to teach or suggest a passport transaction apparatus for processing transactions with a storage medium which stores the data required for issuance of passports and the data for identifying the applicants for the passports, said apparatus comprising: an image input unit for inputting an image of the applicant; a reader unit for reading out the data from said storage medium; a display unit for displaying a guidance for the procedure for the passport transaction; a data input unit for inputting data for passport transactions according to the procedure for passport transactions displayed on said display unit; a printer unit for printing an image inputted by said image input unit and the contents of the passport onto a passport paper previously prepared; an issuer unit for issuing a passport obtained by printing with said printing unit; a control unit for controlling the communications by said communication unit, image input by said image input unit, display by said display unit, reading by said reader unit, data input by

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said data input unit and issuance of a passport by the issuing unit; wherein said control unit determines whether the applied passport is to be issued or not based on the data read out by said reading unit, and when it is determined that the passport is to be issued, has the image of applicant inputted by said image input unit and contents of the passport printed onto a passport paper previously prepared using the printing unit and issues the passport obtained by printing using the issuing unit.

30. Claim 26 would be allowable if rewritten or amended to overcome the objection(s) set forth in this Office action.

31. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken as a whole, fails to teach or suggest a passport transaction method applicable to a system in which a system is connected via a communication line to a center for providing data for issuance of a certificate to an applicant and executing examination for issuance of a passport for processing passport transactions by ways of communication with the center, said method comprising: a first step of inputting data for checking an applicant; a second step of accessing said center and determining whether the applied-for passport is to be issued or not by using the data inputted in the first step; a third step of inputting, when it is determined in the second step that the applied-for passport is to be issued, an image of the applicant; and a fourth step of printing the image of the applicant and contents of description on the passport inputted in the third step onto passport paper previously prepared, and issuing the passport obtained by printing.

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32. Claim 27 would be allowable if rewritten or amended to overcome the objection(s) and rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

33. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken as a whole, fails to teach or suggest a passport transaction apparatus applicable to a system for processing passport transactions with a storage medium storing therein data required for issuance of passports as well as data for identifying applications for passports comprising: a first step of reading out data required for issuance of a passport from the storage medium and data for identifying an applicant; a second step of determining whether the applied-for passport is to be issued or not according to the data read out in the first step; a third step of inputting, when it is determined in the second step that the applied-for passport is to be issued, an image of the applicant; and a fourth step of printing the image of the applicant and contents of description on the passport inputted in the third step and issuing the passport obtained by printing.

34. Claims 28-32 would be allowable if rewritten to overcome the objection(s) and rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

35. The following is a statement of reasons for the indication allowable subject matter: The prior art of record, taken as a whole, fails to teach or suggest a passport transaction system comprising: a center accessibly connected to a first database storing therein data for issuing certificates to applicants, registering data for issuance of passports in a second database, and executing examination for issuance of passports; at least one passport transaction apparatus connected via a communication line to said center for processing passport transactions by

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communicating with said center, wherein said passport transaction apparatus comprises: a communication unit for communicating with said center; an image input unit for inputting an image of the applicant for a passport; a display unit for displaying a guidance for the procedure for passport transaction; a data input unit for inputting data for the application according to the contents of procedure for passport transaction displayed on said display unit; a printer unit for printing the image inputted by the image input unit and contents of description on the passport onto a passport paper previously prepared; an issuer unit for issuing the passport obtained by printing with said printing unit; and a control unit for controlling the communications by said communication unit, display by said display unit, data input by said data input unit, and issuance of a passport by said issuer unit; while the control unit accesses the center using the communication unit, asks the center to make determination as to whether the applied passport is to be issued or not according to the data inputted by the data input unit, and when it is determined that the passport applied for is to be issued, has an image of the applicant inputted by the image input unit and contents of description of the passport printed onto passport paper previously prepared and the passport obtained by printing issued with the issuing unit; and the center verifies the data inputted by the data input unit according to a request from the passport transaction apparatus to the first and second databases respectively by way of communication with the communication unit and returns a reply as to whether each applied-for passport is to be issued or not according to a result of verification.

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36. Claims 33-37 would be allowable if rewritten or amended to overcome the objection(s) and the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

37. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken as a whole, fails to teach or suggest a passport transaction system comprising: a first center having a first database with data required for issuance of certificates for applicants registered therein; a second center for registering data for issuance of passports in a second database and also executing examination for issuance of passports; and at least one passport transaction apparatus connected via a communication line to the first and second centers for processing passport transactions for communicating with the first and second centers; wherein said passport transaction apparatus comprises: a communication unit for communicating with the first and second centers; an image input unit for inputting an image of an applicant for a passport; a display unit for providing guidance with displays of contents of procedure for passport transaction; a data input unit for inputting data for passport transactions according to the contents of procedure displayed on the display unit; a printing unit for printing the image inputted by the image input unit and contents of description of the passport onto passport paper previously prepared; an issuing unit for issuing a passport obtained by printing with the printing unit; and a control unit for providing controls over communication by the communication unit, image input by the image input unit, displays by the display unit, data input by the data input unit, and issuance of passports by the issuing unit; while the control unit accesses the first and second centers respectively using the communication unit, verifies an applicant for a passport according to the

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data inputted with the data input unit, makes determination as to whether an applied-for passport is to be issued or not, and when it is determined that the applied-for passport is to be issued, has the image of the applicant inputted by the image input unit and contents of description on the passport printed with the printing unit onto passport paper previously prepared and also has the passport obtained by printing issued with the issuing unit; wherein the first center verifies the data inputted by the data input unit according to a request for verification of an applicant for a passport from the passport transaction apparatus to the first database by way of communication with the communication unit and returns a reply according to a result of verification as to whether the applicant is the person he claims to be or not; and wherein the second center verifies the data inputted by the data input unit according to a request from the passport transaction apparatus by way of communicating with the communication unit to the second database and returns a reply according to a result of verification as to whether the applied-for passport is to be issued or not.

### *Conclusion*

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maurer et al. disclose an identification card. Hosobuchi et al. disclose a terminal management method and apparatus. Sukegawa et al. disclose a system for issuing resident certificates. Wright et al. disclose a hunting license. Berson et al. disclose a system and apparatus for controlled production of a secure identification card. Hakamatsuka et al. disclose an ID card issuing system. Watanabe discloses a certification card producing apparatus. Ward discloses



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recording of images. Bradley et al. disclose an apparatus for coupling multiple data sources onto a printed document. South et al. disclose a mount for camera-PC terminal. Schwab discloses a secure identification system.

39. Any inquiry concerning this communication or earlier communications from the examiner should be addressed to Nicholas D. Rosen, whose telephone number is (703) 305-0753. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

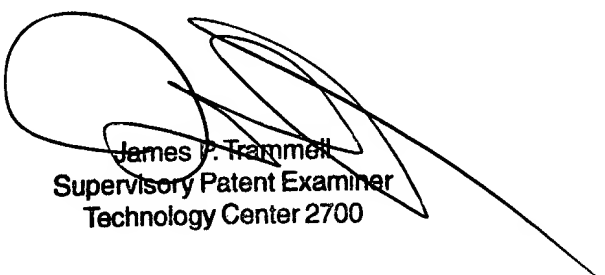
If attempts to reach the examiner are unsuccessful, the examiner's supervisor, James Trammell, can be reached at (703) 305-9768. The fax number for this Group is (703) 308-1396.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to Nicholas.Rosen@uspto.gov.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 305-3900.

*Nicholas D. Rosen*  
Nicholas D. Rosen  
December 9, 1999

  
James P. Trammell  
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